

REMARKS

In accordance with the following, claims 1-10 have been amended, and new claims 11-13 have been added. Claims 1-13 are pending, with claim 1 being independent. No new matter is presented in this Amendment.

Applicants' Statement of Substance of Interview

The Interview Summary mailed September 23, 2008, for the personal interview conducted on September 17, 2008, between Examiner Nathan E. Price, Primary Examiner Li B. Zhen, and the undersigned attorney, Randall S. Svihla, is acknowledged. The mailed Interview Summary is identical to an Interview Summary Messrs. Price and Zhen gave to the attorney at the conclusion of the interview. The applicants' statement of the substance of the interview required by the Interview Summary and MPEP 713.04 was already provided in the Supplemental Response After Final Rejection of September 19, 2008.

Consideration of Arguments Presented After Final Rejection

Please consider the arguments in the Request for Reconsideration After Final Rejection of September 2, 2008, and the Supplemental Response After Final Rejection of September 19, 2008.

Claim Rejections Under 35 USC 101

Claims 1-10 have been rejected under 35 USC 101 as being directed to non-statutory subject matter, with the Examiner setting forth two different bases for the rejection. This rejection is respectfully traversed for the reasons discussed in the Request for Reconsideration After Final Rejection of September 2, 2008, and the Supplemental Response of September 19, 2008, and the additional reasons discussed below.

First Basis for Rejection Under 35 USC 101

The first basis for the rejection under 35 USC 101 is the Examiner's allegation that "[t]he computer-readable medium of claim 1 appears to store only nonfunctional descriptive material."

In the Advisory Action of October 1, 2008, the Examiner states as follows:

With respect to the rejection under 35 U.S.C. 101 for claiming non-functional descriptive material, this basis applies to claim 1.

Regarding claim 1, Applicant argues the claim recites functional descriptive material. However, the claim recites three elements, which are AV data, a markup document and control information. It appears that these elements can be reasonably interpreted as compilations or mere arrangements of data. In this case the elements are nonfunctional descriptive material (see MPEP 2106.01 paragraph 1). Although the data can be used by the apparatus to perform functions, the elements recited as part of the computer-readable medium appear to be reasonably interpreted as compilations or mere arrangements of data. Applicant argues the elements comprise a data structure. Applicant argues the control information of claim 1 may include a program. However, it does not appear to be limited to including a program, but instead, can possible be data used to identify the buffering state. Therefore as explained above, the elements appear to be data.

The applicants disagree with the Examiner's position. It is submitted that the Examiner's interpretation of claim 1 as reciting non-functional descriptive material is contrary to the actual language of claim 1. The Examiner acknowledges that the applicants argued that claim 1 recites a data structure, but the Examiner did not take note of these arguments in the Supplemental Response After Final Rejection of September 19, 2008, and answer the substance of them as required by MPEP 707.07(f).

However, solely in an effort to eliminate this issue and advance the prosecution of the application, claim 1 has been amended to recite the following feature:

control information providing functionality to enable the apparatus to identify buffering state information of the markup document to be preloaded into the buffer of the apparatus, the buffering state information being used by the apparatus in reproducing the AV data in the interactive mode selected by the user.

It is submitted that claim 1 now unquestionably recites functional descriptive material, and is therefore statutory under 35 USC 101.

Second Basis for Rejection Under 35 USC 101

The second basis for the rejection under 35 USC 101 is the Examiner's position as set forth in paragraph 5 on page 3 of the Final Office Action of July 2, 2008, which reads as follows:

Regarding Applicant's amendment to the specification, although Applicant indicates the amendment addresses the rejection under 35 USC 101, Applicant has not specifically disavowed the disclosure that precedes the amendment. Additionally, the amendment removes carrier wave from the examples of storage media, but it is not clear that carrier wave is not disclosed as an example of a computer readable medium.

In the Advisory Action of October 1, 2008, the Examiner states as follows:

Regarding the carrier wave, the amendment to the specification removes carrier wave as a specifically disclosed form of storage. However, even with the amendment to the specification, it remains reasonable to interpret "computer-readable medium" as a carrier wave. The rejection can be overcome by directing the claim to a computer-readable storage medium and stating that the amendment to the specification is intended to remove carrier wave from the subject matter claimed by reciting computer-readable medium. However, the exact wording used by Applicant will need to be fully considered before the rejection can be withdrawn.

It is submitted that the Examiner's position is completely unsupported by law. The Examiner has not cited a single statute, rule, procedure, guideline, or decision in support of his position, despite the applicants' repeated requests that he do so. During a telephone discussion on October 1, 2008, between Examiner Price and the undersigned attorney, Randall S. Svihla, Mr. Price said that he had been instructed to make this rejection by a WQAS (Workgroup Quality Assurance Specialist) in Technology Center 2100. The attorney asked for the name of the WQAS, but the Examiner declined to provide it.

Should the Examiner repeat the rejection in the next Office Action, it is respectfully requested that the Examiner provide the name of the WQAS who instructed the Examiner to make the rejection. Should the Examiner be inclined not to provide the name of the WQAS, it is respectfully requested that the Examiner consult with the Director of his Technology Center before doing so.

However, solely in an effort to eliminate this issue and advance the prosecution of the application, claims 1-10 have been amended to recite "a compute-readable storage medium."

In the decision of *In re Nuijten*, 500 F.3d 1346, 84 USPQ2d 1495 (Fed. Cir. 2007), a three-judge panel of the Court of Appeals for the Federal Circuit held in a split decision that Nuijten's signal claims are not patentable subject matter under 35 USC 101. However, it is submitted that the law is hardly settled on this issue, and it is unlikely that *Nuijten* will be the last word on this issue.

However, under the current state of the law as set forth in *Nuijten*, a carrier wave would appear to be nonstatutory subject matter. Accordingly, under the current state of the law as set forth in *Nuijten*, the applicants do not intend for the "computer-readable storage medium" recited in claim 1 to cover a carrier wave.

However, should the state of the law change and a carrier wave become statutory subject matter in the future, for example, due to a change in 35 USC 101 enacted by Congress, or a unanimous decision of a three-judge panel of the Federal Circuit, or an *en banc* decision of the Federal Circuit, or a decision of the U.S. Supreme Court, the applicants intend that the "computer-readable storage medium" recited in claim 1 cover a carrier wave under such future state of the law.

Conclusion—Claim Rejections Under 35 USC 101

For at least the foregoing reasons and the reasons discussed in the Request for Reconsideration After Final Rejection of September 2, 2008, and the Supplemental Response of September 19, 2008, it is respectfully requested that the rejection of claims 1-10 under 35 USC 101 be withdrawn.

Claim Rejections Under 35 USC 102 and 103

Claims 1, 2, 5, and 8-10 have been rejected under 35 USC 102(b) as being anticipated by Sullivan et al. (Sullivan) ("Programming with the Java Media Framework").

Claims 3, 4, 6, and 7 have been rejected under 35 USC 103(a) as being unpatentable over Sullivan.

These rejections are respectfully traversed for the reasons discussed in the Request for Reconsideration After Final Rejection of September 2, 2008, and the Supplemental Response of September 19, 2008, and the additional reasons discussed below.

Claims 1 and 10

In the Advisory Action of October 1, 2008, the Examiner states as follows:

Applicant further argues that Sullivan fails to teach preloading of a markup document. However, Sullivan teaches multimedia as part of web pages (p. 75 paragraph 1). Therefore, the multimedia is interpreted as part of the markup document disclosed by Sullivan. With respect to the AV data separately recited from the markup document, Sullivan teaches AV data files being selected not only by the programmer (p. 75 "filename") ,but also by a user (p. 96 first full paragraph). Therefore, Sullivan teaches the presence of additional AV data not incorporated into the markup document.

However, page 96, first full paragraph, of Sullivan relates to FIG. 10.1 of Sullivan, which has absolutely nothing whatsoever to do with FIG. 9.2 of Sullivan, which the Examiner considers to show the "interactive mode selected by a user" recited in claim 1. Furthermore, the Examiner has not provided any explanation of how FIGS. 9.2 and 10.1 of Sullivan would be combined to provide the combination of features recited in claim 1, or identified any reasons why one of ordinary skill in the art would make such a combination.

In any event, solely in an effort to eliminate this issue and advance the prosecution of the application, claim 1 has been amended to recite the following features:

a markup document to be preloaded into the buffer of the apparatus to enable the apparatus to reproduce the AV data in an interactive mode selected by a user of the apparatus, wherein the markup document does not comprise the AV data or any other AV data; and

control information providing functionality to enable the apparatus to identify buffering state information of the markup document to be preloaded into the buffer of the apparatus, the buffering state information being used by the apparatus in reproducing the AV data in the interactive mode selected by the user.

Page 29 ¶1 of Sullivan states that "[t]he purpose of the Java Media Player API is to control and present time-based media streams." Page 33 ¶2 of Sullivan states that "[t]he CachingControl object monitors the Player's progress in downloading media data." Page 34 ¶3 of Sullivan states that "[i]t is assumed that Players are implementations for streams that have audio and visual renderers," and that "[t]he Player interface provides methods for view and controlling the audio and video clips." Page 75 ¶1 of Sullivan states that "[y]ou can enhance a website by adding audio and video to the web pages." Page 77 ¶2 of Sullivan states that "[t]he applet can play back any file type that is supported by the Java Media Framework runtime;" that "[t]o play an AVI file, simply set the applet's filename parameter to *yourfile.avi*;" and that "[t]o play an MPEG-1 file, set the filename parameter to *yourfile.mpg*." Page 82 ¶2 of Sullivan states that "[t]he Java Media Framework makes it easy to build multimedia Java applets;" that "[t]he VideoApplet can be used to enhance web pages with video;" that "[t]he ScriptableMediaApplet is an example of how applets can be combined with JavaScript on a web page;" and that "[t]he JarAudioApplet efficiently adds background music to web pages." Page 95 ¶1 of Sullivan states that "[t]he process can include all of the following tasks: thread creation, memory buffer allocation, loading data into buffers, acquisition of system-dependent resources, connection to a remote server, and download of media data from the network;" that "the download of media data is usually the most time consuming;" and that "[t]he Java Media Player API was designed so that the download of the media data occurs asynchronously." Page 95 ¶2 of Sullivan relied on by the Examiner, which includes the heading "Media Data Download Event Notification," states that "[o]bjects that need to track the progress of the data download should implement the ControllerListener interface to receive notification of caching state changes," and that "[t]he Player notifies all registered listeners of caching state changes by sending a CachingControlEvent." Page 95 ¶3 and page 96 ¶1-4 of Sullivan states that "[t]he CachingControl provides information about the progress of the media data download," and that "[a] CachingControl has five methods: . . . **isDownloading** returns a boolean value which indicates if the media data is being downloaded; **getContentLength** returns the total number of bytes in the media being downloaded . . . **getContentProgress** . . . **getProgressBarComponent** . . . **getControlComponent**" Page 100 last ¶ of Sullivan states that "[t]he media data download is a time-consuming process;" that "[t]he media files can be very large, which means that the user may have to wait before a file is ready to play;" and that "[t]hrough the use of the CachingControl and the progress bar, an application can provide

feedback to the end user." Page 177 last ¶ of Sullivan states that "[w]hen the Player posts a PrefetchCompleteEvent, it indicates that the Player has reached the prefetched state," and that "[i]n response to the event, the applet calls Player.start to start media playback."

It is submitted that it is readily apparent from the above portions of Sullivan that Sullivan relates to downloading and playing back audio and video data, like the "audio video (AV) data" recited in claim 1. Furthermore, although these portions of Sullivan may arguably be considered to disclose AV data to be preloaded into a buffer of an apparatus, and control information to enable the apparatus to identify buffering state information of the AV data to be preloaded into the buffer of the apparatus, it is submitted that nothing whatsoever in these portions of Sullivan or any other portion of Sullivan discloses or suggests "a markup document to be preloaded into the buffer of the apparatus to enable the apparatus to reproduce the AV data in an interactive mode selected by a user of the apparatus, wherein the markup document does not comprise the AV data or any other AV data as now recited in claim 1, or "control information providing functionality to enable the apparatus to identify buffering state information of the markup document to be preloaded into the buffer of the apparatus, the buffering state information being used by the apparatus in reproducing the AV data in the interactive mode selected by the user" as now recited in claim 1.

Conclusion—Claim Rejections Under 35 USC 102 and 103

For at least the foregoing reasons and the reasons discussed in the Request for Reconsideration After Final Rejection of September 2, 2008, and the Supplemental Response of September 19, 2008, it is respectfully requested that the rejection of claims 1, 2, 5, and 8-10 (i.e., claim 1 discussed above and claims 2, 5, and 8-10 depending from claim 1) under 35 USC 102(b) as being anticipated by Sullivan be withdrawn, and that the rejection of claims 3, 4, 6, and 7 depending directly or indirectly from claim 1 discussed above under 35 USC 103(a) as being unpatentable over Sullivan be withdrawn.

Patentability of New Claims 11-13

It is submitted that Sullivan does not disclose or suggest the following features of new dependent claim 11:

11. The computer-readable storage medium of claim 1, further having recorded thereon a startup markup document separate from the markup document to be preloaded into the buffer of the apparatus and comprising preloading instructions enabling the apparatus to preload the markup document into the buffer of the apparatus;

wherein the selection of the interactive mode by the user causes the apparatus to read the startup markup document from the computer-readable storage medium and execute the preloading instructions to preload the markup document into the buffer of the apparatus,

or the following features of new dependent claim 12:

12. the computer-readable storage medium of claim 1, further having recorded thereon a preload list file listing the markup document to be preloaded into the buffer of the apparatus;

wherein the preloading instructions comprise:

at least one instruction enabling the apparatus to read the preload list file from the computer-readable storage medium;

at least one instruction enabling the apparatus to read the markup document to be preloaded into the buffer of the apparatus from the computer-readable storage medium based on the listing of the markup document in the preload list file; and

at least one instruction enabling the apparatus to preload the markup document into the buffer of the apparatus.

or the following feature of new dependent claim 13:

wherein the user does not select the interactive mode by accessing the markup document.

For at least the foregoing reasons, it is submitted that new claims 11-13 are patentable over Sullivan, and an indication to that effect is respectfully requested.

Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with the filing of this paper, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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